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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/533,361      | 03/22/2000  | Beatrice Toumi       | 6388-0501-0         | 9261             |

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| EXAMINER |
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WELLS, LAUREN Q

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1617

DATE MAILED: 05/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                |              |
|------------------------------|----------------|--------------|
| <b>Office Action Summary</b> | Applicant No . | Applicant(s) |
|                              | 09/533,361     | TOUMI ET AL. |
|                              | Examiner       | Art Unit     |
|                              | Lauren Q Wells | 1617         |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 March 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,17-22 and 24-47 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,17-22 and 24-47 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Claims 1-3, 17-22, 24-47 are pending. The Amendment filed 3/18/03, Paper No. 23, amended claims 1-3, 20-21, 30, added claims 31-47, and cancelled claims 11-16.

### ***Response to Arguments***

Applicant's arguments toward the 35 USC 103 rejection in the previous Office Action, with respect to claims 1-3, 17-22, 24-47, have been considered but are moot in view of the new ground(s) of rejection. However, to the extent that the arguments may be relevant to the instant rejection, the Examiner will address them.

The Amendment to the claims and arguments filed 3/18/03, Paper No. 23, are persuasive to overcome the 35 USC 112, 2<sup>nd</sup> paragraph rejections, and the 112, 1<sup>st</sup> paragraph, rejections.

Applicant argues, “Kumar neither teaches nor suggests applying the claimed polymers to wrinkled skin in a wrinkle reducing effective amount or to skin suffering from signs of cutaneous again in a signs of cutaneous ageing reducing amount. . .Kumar neither teaches nor suggests that claimed polymers”. This argument is not persuasive. First, as laid out below, the Examiner respectfully points out that Kumar teaches the silicone grafted polymers comprising units of formula (IV) of the instant invention. The Examiner is not clear as to why Applicant does not agree that they are the same compounds.

Second, the Examiner respectfully points out that the recitation of “a wrinkle reducing effective amount” and “cutaneous aging reducing amount” are met, as the effective amounts recited in the specification encompass the effective amount taught by Kumar.

Third, the Examiner respectfully points out that all skin, once out of childhood, contains wrinkles and the signs of cutaneous aging.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-18, 24, 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 17-18, 24, 31-33 are vague and indefinite, as they are confusing. Claims 17-18, 24 and 31-33, depend from claim 16, which has been cancelled.

(ii) Claim 22 recites the limitation "of claim 20, wherein the compounds are selected from" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim, as claim 20 does not recite any compounds.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 17-19, 24-29, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al.

The instant invention is directed toward a method of applying to the skin a composition comprising an effective amount of a grafted silicone polymer comprising, in its structure, a unit of formula (IV). The instant invention is also directed toward a composition comprising such compounds.

Kumar et al. teach vinyl silicone polymers in cosmetic and personal care compositions. The compositions provide moisture-retaining properties by retarding the evaporation of moisture through the skin, and teaches foundations as cosmetic forms of the composition. Disclosed as the vinyl silicone polymers are grafted silicone polymers of formula (IV) of the instant invention. Isocetyl(meth)acrylate, isononyl (meth)acrylate, 2-ethylhexyl (methacrylate), acrylic acid, methacrylic acid, itaconic acid, and others are disclosed as monomers for “G3” and “G4” of formula (IV). The polymer is disclosed as comprising 5-60% of the composition. Exemplified is a face cream comprising 2% of a grafted mercapto-functional silicone polymer comprising ethylhexyl methacrylate and i-butyl methacrylate as vinyl monomers side-chains. It is noted that the limitations, “reducing or removing effective amount”, the “skin-tightening effective amount”, and the “wrinkle removing effective amount”, are met, as these effective amounts, recited in claim 19 and the specification, encompass the effective amount of the exemplified face cream of Kumar et al. and the teaching of the polymers as comprising 5-60% of the composition.

The reference lacks an exemplification of a skin composition comprising a grafted silicone copolymer comprising at least one anionic non-silicone organic monomer and at least one hydrophobic non-silicone organic monomer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kumar et al. to exemplify a grafted copolymer comprising, in its structure, the unit of formula (IV), because Kumar et al. teaches grafted silicone copolymers comprising units of formula (IV), and because of the expectation of achieving a composition that provides moisture-retaining properties by retarding evaporation of moisture through the skin.

The claims are directed to a method of applying a composition comprising a grafted silicone polymer having, in its structure, the unit of formula (IV), to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently tighten skin, reduce wrinkles, and treat cutaneous aging, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Claims 21-22, 30, 35, 37-39, 41-45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. as applied to claims 1-3, 17-19, 24-29, 31-33 above, and further in view of Hasenoehrl et al. (6,190,678).

Kumar et al. is applied as discussed above. The reference lacks slimming, firming, antiglycant and/or vasoprotective compounds.

Hasenoehrl et al. teach cleansing and conditioning products for skin or hair with improved deposition of conditioning ingredients. Caffeine is disclosed as a skin barrier repair active agent that helps repair and replenish the natural moisture barrier function of the epidermis. See abstract; Col. 34, lines 25-59.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the caffeine of Hasenoehrl et al. to the composition of Kumar et al. because Kumar et al. teach their compositions for the skin and for providing moisture-retaining properties, and Hasenoehrl et al. teach caffeine as a moisture-retaining active agent; hence, adding caffeine to the composition of Kumar et al. would be within the skill of one in the art because of its additive moisturizing effects.

Claims 20, 34, 36, 40, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. as applied to claims 1-3, 17-19, 24-29, 31-33 above, and further in view of Delrieu et al. (6,319,507).

Kumar et al. is applied as discussed above. The reference lacks plant proteins.

Delrieu et al. teach plant proteins as dermally active/dermally effective substances having biological or cosmetic activity, which can be topically delivered. Plant proteins have skin moisturizing benefits. See Col. 11, lines 9-31.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add plant proteins, as taught by Delrieu et al., to the composition of Kumar et al. because of the expectation of achieving a skin care cosmetic with enhanced dermal activity and skin moisturizing benefits.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1617

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
May 5, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER  
5/4/03